



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,228	03/14/2001	Brian W. McKinnon	10557/199332	5554

30559 7590 10/06/2005

CHIEF PATENT COUNSEL
SMITH & NEPHEW, INC.
1450 BROOKS ROAD
MEMPHIS, TN 38116

EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
----------	--------------

3738

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,228

Applicant(s)

MCKINNON, BRIAN W.

Examiner

Thomas C. Barrett

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-182 is/are pending in the application.
- 4a) Of the above claim(s) 1-101, 111-115, 131-134, 136, 137, 140-142 and 144-181 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 182 is/are allowed.
- 6) ☒ Claim(s) 102-110, 116-130, 135, 138, 139 and 143 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 102-110, 116-130, 135, 138, 139, 143 and 182 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a plurality of optimized angles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As noted in the prior office action, the phrase "variable angle chamfer" has not been defined in the specification and therefore read broadly. In addition, please note that the present specification discloses, "the angle may also be defined relative to any reference line or plane defined by the structure of the liner, such as the center axis or an axis of rotation of the inner diameter, the center axis or axis of rotation of the external, or outer, diameter, or some other reference entity." The chamfer rims of the cited prior art all vary relative to a "reference entity." For example, there are an infinite number of reference lines "defined by structure of the liner." In other words "a variable angle chamfer" relative to a **specific** line, plane etc. as in claim 182, might better define the invention. The prior art cited below all have chamfers with angles that vary, i.e. the liner with the "small chamfer" of Thornberry et al. varies at the three notches on the chamfer

or the "wide chamfer" angle varies as the chamfer curves upwards. However, if the Applicant were to include the additional limitations of new claim 182 (i.e. each variable angle defined...) into claim 102, it would overcome the prior cited art and claim 102 would be allowable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 102-110, 116, 135, 138-139 and 143 are rejected under 35 U.S.C. 102(b) as anticipated by Thornberry et al. as disclosed in applicant's IDS. Thornberry et al. disclose a prosthetic device comprising: an acetabular shell, an acetabular liner and a femoral component. (See "Results and Discussion"). The rim of the liner comprises a variable angle chamfer ("wide chamfer") and is symmetric about a plane ("small chamfer").

Claims 102 and 117-124 are rejected under 35 U.S.C. 102(b) as anticipated by Smith & Nephew (Reflection Lateralized Liners...) as disclosed in applicants IDS. Smith & Nephew discloses a prosthetic device comprising: an acetabular shell and an acetabular liner. The liner has a distance across the opening of the internal concave surface of 28mm, a shoulder, a serrated locking surface and a lateral offset of 4mm. The external surface of the "Lateralized Liners" is adapted to be received in a

"Reflection InterFit" acetabular shell, which, as disclosed in the "Catalog Information" of "Smith & Nephew Surgical Technique" as cited in applicant's IDS, has an external diameter of 42-76 mm. The rim of the liner comprises a variable angle chamfer.

Claims 102 and 126-130 are rejected under 35 U.S.C. 102(b) as anticipated by Lennox. Lennox discloses a prosthetic device comprising: an acetabular shell and an acetabular liner (Fig. 1). The liner has a center axis oriented 20 degrees to the axis of the shell (col. 8, lines 51-64). The rim of the liner comprises a variable angle chamfer

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 102, 122 and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith & Nephew (Reflection Lateralized Liners.... Smith & Nephew discloses a prosthetic device comprising: an acetabular shell, an acetabular liner and medially shifted liner (Fig. 4) however Smith & Nephew fails to disclose the liner shifted medially specifically up to 8 mm.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to shift the liner medially specifically up to 8 mm. Applicant has not disclosed that shifting the liner medially specifically up to 8 mm provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary

Art Unit: 3738

skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the liner medially shifted specifically up to 8 mm because there is no disclosed advantage over a specific length of medial shift.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Smith & Nephew to obtain the invention as specified in claim 125.

Allowable Subject Matter

Claim 182 is allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Thomas Barrett', with a stylized flourish at the end.

Thomas Barrett
Examiner
Art Unit: 3738